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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,016	12/09/2003	Hironori Noto	10517/203	2723
23838	7590	11/13/2006		
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
			EXAMINER CHU, HELEN OK	
			ART UNIT 1745	PAPER NUMBER

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/730,016	<b>Applicant(s)</b> NOTO, HIRONORI	
	<b>Examiner</b> Helen O. Chu	<b>Art Unit</b> 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/26/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. Applicant's Arguments/Remarks has been received on October 26, 2006. Claim 1 has been amended.

The text of those sections of Title 35, U.S.C. code not included in this action can be found in the prior Office Action.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 26, 2006 has been entered.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation "another surface" is not clear to the Examiner as to which element the Applicants are claiming, therefore, for purposes of prosecution the Examiner is interpreting any surface on the stacked cell unit to be equivalent to the Applicant's claim.

***Claim Rejections - 35 USC § 102***

5. The rejections under 35 U.S.C 102 (b), on claims 1, 3-12 as anticipated by Hartvigsen et al. are withdrawn because Applicant has amended claim 1.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-6, 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Unkle et al. (US Patent 3,717,505).

In regard to claims 1, 3, 4, 6, 9, 10, 12 and 13, the Unkle, Jr. et al. reference discloses a fuel cell stack (Abstract) with frames (Applicant's separators; Figure 2, Component 15) separating successive electrode assemblies (Figure 2, Component 13). The stack cells have manifolds formed within the separators. The Unkle, Jr. et al. reference illustrates in Figure 3a component 35 is an internal passage system in the front end plate which is connected by suitable fittings 37 (Applicant's sleeve) to both of the electrodes of the first electrode subassemblies. These fittings provide a gas to the front surface of the first electrode assembly, and each electrode assembly (Column 2, Lines 57-63). Figure 3A also illustrates the internal manifold is tapered and substantially smooth.

In regard to claims 5 and 11, the Hartvigsen et al. reference discloses bonding and sealing the frame (Column 2, Lines 11-14).

In regards to claim 8, the Unkle, Jr. et al. reference illustrates an external surface parallel to the cell stack direction (Figure 3).

8. Claims 1, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonk et al. (US Publication 2001/0001052 A1).

In regard to claims 1, 6, 7, the Bonk et al. discloses PEM fuel cell (Paragraph 27) stack with separators (Paragraph 50) and an internal manifold that is smooth (Figure 1)

9. It is noted that claim 1, 3-5, 10-13 are product-by-process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Since the disclosed invention of Unkle, Jr. et al. reference is similar to that of the Applicant's, Applicant's process is not given patentable weight in this claim.

### ***Claim Rejections - 35 USC § 103***

10. The rejections under 35 U.S.C 103 (a), on claim 12, as anticipated by Hartvigsen et al. in view of Grasso et al. is withdrawn because Applicant has amended claim 1.

### ***Response to Arguments***

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11. Applicant's arguments with respect to claims 1, 3-12 has been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen O. Chu whose telephone number is (571) 272-5162. The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HOC

  
TRACY DOVE  
PRIMARY EXAMINER

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